

REMARKS

Claims 1-5 have been examined. New claim 6 has been added. Claims 1-6 remain in the application.

Claims 1-5 were rejected under 35 U.S.C. § 103(a) as unpatentable based upon Jawanda and by the USPTO taking official notice of a wireless local area network ("WLAN") that may be operated inside a vehicle or its proximity and in communication with wireless wide area network ("WWAN"). The USPTO provided Clark as a reference that supports its assertion that this element is well known. To better understand the references, the problems that each reference sought to resolve and a description of their respective systems are briefly presented.

Jawanda sought to address the problem involving the termination of an active session due to the mobile portable computer system leaving a designated service area for the wireless data communication network. Jawanda teaches an access arbitrator configured to seamlessly hand off data from a cellular wireless communication network to the WLAN when the portable computer system moves outside of the service area.

Clark, on the other hand, sought to solve the problem involving the lack of an integrated mobile network computing technology that satisfies the requirements of motion picture, television ("TV"), and TV advertising production. Clark teaches a telecomputer network that includes a WWAN, a WLAN, and a mobile hub (e.g. a van). The WWAN comprises a redundant digital microwave communication system configured to operate as an intranet whereas the WLAN includes a plurality of nodes with at least one computer at each node.

To establish a *prima facie* obviousness rejection under 35 U.S.C. § 103(a), the USPTO must explain why one skilled in the art would combine elements in which the USPTO has

applied the principle of official notice with another reference. (See, for example, *Ex parte Grochowski*, No. 95-1343, at 5 (Bd.Pat.App. & Int. June 27, 1995) observing "that just because elements are old and well known in the art does not render their combination obvious per se"). The rejection under 35 U.S.C. § 103(a) should be withdrawn because the USPTO did not meet this burden.

The USPTO used broad conclusory statements to explain why it combined a reference with a "well known" element. In particular, the USPTO merely stated that "Clark ... teaches the utilization of a wireless local area network unit (103A, 103B) inside a vehicle to provide data communication between a wireless wide area network and a wireless local area network which can easily be adopted by one of ordinary skill in the art into the system of Jawanda to provide a wireless communication system with mobility to further enhance the system capability and performance." Office Action dated October 2, 2003, page 3. A similarly broad conclusory statement was rejected by the Board of Patent Appeals and Interferences ("the Board") in the case entitled *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000). In that case, the examiner stated:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above references' teachings as taught by Sun et al., Lee et al., and Sandhu et al. because such use of planarized plugs by CMP [chemicalmechanical polishing] or etchback and the claimed deposition processes and materials are conventional and obvious as evidenced by Sun et al., Lee et al., and Sandhu et al. to enable the formation of a planarized plug for contact.

In reversing the examiner's rejection of the pertinent claims, the Board, in *Ex Parte Huang*, No. 1997-3338, (Bd. Pat. App & Int. 1997), relied upon the decision of *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), which stated:

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

The Board then stated that "the examiner has not identified any motivation, suggestion or teaching of the desirability of combining Koyanagi or Scovell with Tsang, Shappir, Lee, Sun, and Sandhu to arrive at the appellants' claimed invention. Our reviewing court has made it clear that 'the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.'" *Id.* As a part of this requirement, the USPTO must provide particular findings as to the "identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis." See *Dembiczak*, 175 F.3d 994, 1000, 50 U.S.P.Q.2d 1614, 1617. Broad conclusory statements standing alone are not "evidence." *Id.* Based upon this ruling and the similarity of statements made by the examiner in *Ex Parte Huang* and the present case, the USPTO has clearly failed to meet its burden on showing the motivation to combine the references.


In addition, Applicants respectfully assert that there is no motivation to combine Jawanda with Clark. For example, one skilled in the art would not look to either Jawanda or Clark to solve the problem confronted by the inventors of the present invention. In particular, the inventors of the present invention sought to reduce the cost of their communication system by

eliminating buses between electronic devices and the WLAN located within the vehicle. As described above, both of these references relate to very different problems than the claimed invention.

Based on all of the foregoing, Applicants believe that all pending claims are in condition for allowance and notice to such effect is respectfully requested at the earliest possible date.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on December 15, 2003.


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